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09/964,787	09/28/2001	Tomoaki Endoh	35.C15845	3430

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EXAMINER

DULANEY, BENJAMIN O

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/964,787	<b>Applicant(s)</b> ENDOH, TOMOAKI	
	<b>Examiner</b> Benjamin O. Dulaney	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 13-26, 28-30 and 32-44 is/are rejected.
- 7) ☒ Claim(s) 8, 12, 27, and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. 09/964,787.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 5-7, 9-11, 20-22, 24-26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,987,228 by Nishizawa, and further in view of U.S. Patent 6,859,832 by Gecht et al.

2. Regarding claims 1 and 20, Nishizawa teaches peripheral equipment connected to a network and managed by a directory server on said network (Column 2, lines 31-40) and control means for limiting execution of said job based on decryption results of said decrypting means (Column 3, lines 2-8).

Nishizawa does not teach decrypting means for decrypting an access ticket of said peripheral equipment included in a job received from an information processing apparatus on said network.

Gecht does teach decrypting means for decrypting an access ticket of said peripheral equipment included in a job received from an information processing apparatus on said network (Column 9, lines 4-8).

Nishizawa and Gecht are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nishizawa by Gecht to add encryption/decryption security. The motivation for doing so would have been for security because "it is very desirable to protect any proprietary or confidential information that may be embodied in the print jobs" (Column 9, lines 1-3). Therefore it would have been obvious to combine Nishizawa with Gecht to obtain the invention as specified in claims 1 and 20.

3. Regarding Claims 2 and 21, Nishizawa further teaches the peripheral equipment according to claim 1, wherein said control means does not execute said job in the case where it is determined by said decrypting means that said access ticket is not valid (Column 2, 58-59).

4. Regarding claims 3 and 22, Nishizawa further teaches the peripheral equipment according to claim 1, wherein said control means obtains, from said directory server, limit information on said job corresponding to the information decrypted by said decrypting means and limits execution of said job based on the limit information (Column 3, lines 2-8; Figure 3).

5. Regarding claims 5 and 24, Nishizawa teaches peripheral equipment connected to a network and managed by a directory server on said network (Column 2, lines 31-40), comprising: receiving means for receiving a control command for a job from an information processing apparatus on said network (Column 3, lines 2-8; Figure 1); and control means for limiting execution of said control command based on decryption results of said decrypting means (Column 3, lines 2-8).

Nishizawa does not teach decrypting means for decrypting an access ticket of said peripheral equipment included in said control command.

Gecht does teach decrypting means for decrypting an access ticket of said peripheral equipment included in said control command (Column 9, lines 4-8).

Nishizawa and Gecht are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nishizawa by Gecht to add encryption/decryption security. The motivation for doing so would have been for security because "it is very desirable to protect any proprietary or confidential information that may be embodied in the print jobs" (Column 9, lines 1-3). Therefore it would have been obvious to combine Nishizawa with Gecht to obtain the invention as specified in claims 5 and 24.

6. Regarding claims 6 and 25, Nishizawa further teaches the peripheral equipment according to claim 5, wherein said control means does not execute said control command in the case where it is determined by said decrypting means that said access ticket is not valid (Column 2, lines 58-59).

7. Regarding claims 7 and 26, Nishizawa does not teach the peripheral equipment according to claim 5, wherein, in the case where said control command is one for displaying a list of jobs, said control means changes a display form of the list based on the decryption results of said decrypting means.

Gecht does teach the peripheral equipment according to claim 5, wherein, in the case where said control command is one for displaying a list of jobs, said control means

changes a display form of the list based on the decryption results of said decrypting means (Column 10, lines 50-55).

Nishizawa and Gecht are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nishizawa by Gecht to add a list of jobs personalized to the identified user. The motivation for doing so would have been for security because it is good security practice to continue to keep data restricted to those to whom it belongs. Therefore it would have been obvious to combine Nishizawa with Gecht to obtain the invention as specified in claims 7 and 26.

8. Regarding claims 9 and 28, Nishizawa teaches peripheral equipment connected to a network and managed by a directory server on said network (Column 2, lines 30-32), comprising: obtaining means for logging in to said directory server based on information inputted from an operation panel and obtaining an access ticket of said peripheral equipment corresponding to the inputted information from said directory server (Column 2, lines 40-46); inputting means for, after obtaining said access ticket, inputting a control command for the Job from said operation panel (Column 2, lines 40-46); and control means for limiting execution of said control command based on decryption results of said decrypting means (Column 3, lines 2-8).

Nishizawa does not teach decrypting means for decrypting said access ticket.

Gecht does teach decrypting means for decrypting said access ticket (Column 9, lines 4-8).

Nishizawa and Gecht are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nishizawa by Gecht to add encryption/decryption security. The motivation for doing so would have been for security because "it is very desirable to protect any proprietary or confidential information that may be embodied in the print jobs" (Column 9, lines 1-3). Therefore it would have been obvious to combine Nishizawa with Gecht to obtain the invention as specified in claims 9 and 28.

9. Regarding claims 10 and 29, Nishizawa further teaches the peripheral equipment according to claim 9, wherein said control means does not execute said control command in the case where it is determined by said decrypting means that said access ticket is not valid (Column 2, 58-59).

10. Regarding claims 11 and 30, Nishizawa does not teach the peripheral equipment according to claim 9, wherein, in the case where said control command is one for displaying a list of jobs, said control means changes a display form of the list based on the decryption results of said decrypting means.

Gecht does teach the peripheral equipment according to claim 9, wherein, in the case where said control command is one for displaying a list of jobs, said control means changes a display form of the list based on the decryption results of said decrypting means (Column 10, lines 50-55).

Nishizawa and Gecht are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nishizawa by Gecht to add a list of jobs personalized to the identified user. The motivation for doing so would have been for security because it is good security practice to continue to keep data restricted to those to whom it belongs. Therefore it would have been obvious to combine Nishizawa with Gecht to obtain the invention as specified in claims 11 and 30.

11. Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,987,228 by Nishizawa, and further in view of U.S. Patent 6,859,832 by Gecht et al., and further in view of U.S. Patent 6,064,836 by Nakamura et al.

Nishizawa does not teach the peripheral equipment according to claim 3, wherein said job is a print job, and said limit information is information indicating the permitted number of prints.

Gecht does not teach the peripheral equipment according to claim 3, wherein said job is a print job, and said limit information is information indicating the permitted number of prints.

Nakamura does teach the peripheral equipment according to claim 3, wherein said job is a print job, and said limit information is information indicating the permitted number of prints (Column 6, lines 37-48).

Nishizawa, Gecht and Nakamura are combinable because they are all from the printing field of endeavor.



It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Nishizawa and Gecht by Nakamura to keep track of how many prints each user is allowed. The motivation for doing so would have been to "provide a supervisory system which restricts the number of times an image is formed by one user using an image forming apparatus within a predetermined upper limit" (Column 2, lines 20-24). Therefore it would have been obvious to combine Nishizawa and Gecht with Nakamura to obtain the invention as specified in claims 4 and 23.

12. Claims 13-17, and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,151,464 by Nakamura et al. (referred to as "reference one"), and further in view of U.S. Patent 6,064,836 by Nakamura et al. (referred to as "reference two").

Regarding claims 13 and 32, reference one teaches a copier connected to a network and managed by a directory server on said network, comprising: operating means for inputting user information on order to log in to said directory server and directing a copy job to start (Column 20, lines 23-29); obtaining means for logging in to said directory server and then obtaining management information corresponding to said user information from said directory server (Column 20, lines 30-39);

Reference one does not teach control means for limiting execution of said copy job based on said management information.

Reference two does teach control means for limiting execution of said copy job based on said management information (Column 6, lines 37-48).

Reference one and reference two are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify reference one by reference two to provide control means for limiting execution of a copy job. The motivation for doing so would have been to “provide a supervisory system which restricts the number of times an image is formed by one user using an image forming apparatus within a predetermined upper limit” (Column 2, lines 20-24). Therefore it would have been obvious to combine reference one and reference two to obtain the invention as specified in claims 13 and 32.

13. Regarding claims 14 and 33, reference one further teaches the copier according to claim 13, wherein, on logging in from a client computer on said network to said directory server, said user information is inputted to said client computer (Column 20, lines 23-29).

14. Regarding claims 15 and 34, reference one does not teach the copier according to claim 13, wherein said management information includes the permitted number of prints.

Reference two does teach the copier according to claim 13, wherein said management information includes the permitted number of prints (Column 6, lines 37-48).

Reference one and reference two are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify reference one by reference two to keep track of how many prints a user is allowed. The motivation for doing so would have been to "provide a supervisory system which restricts the number of times an image is formed by one user using an image forming apparatus within a predetermined upper limit" (Column 2, lines 20-24). Therefore it would have been obvious to combine reference one and reference two to obtain the invention as specified in claims 15 and 34.

15. Regarding claims 16 and 35, reference one does not teach the copier according to claim 13, wherein said management information includes the accumulated number of prints.

Reference two does teach the copier according to claim 13, wherein said management information includes the accumulated number of prints (Column 6, lines 37-48).

Reference one and reference two are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify reference one by reference two to keep track of how many prints a user has printed. The motivation for doing so would have been to "provide a supervisory system which restricts the number of times an image is formed by one user using an image forming apparatus within a predetermined upper limit" (Column 2, lines 20-24). Therefore it would have been obvious to combine reference one and reference two to obtain the invention as specified in claims 16 and 35.

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16. Regarding claims 17 and 36, reference one does not teach the copier according to claim 13, further comprising; renewing means for renewing management information managed by said directory server corresponding to said user information according to execution results of said copy job.

Reference two does teach the copier according to claim 13, further comprising; renewing means for renewing management information managed by said directory server corresponding to said user information according to execution results of said copy job (Column 6, lines 37-48).

Reference one and reference two are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify reference one by reference two to renew management information. The motivation for doing so would have been to "provide a supervisory system which restricts the number of times an image is formed by one user using an image forming apparatus within a predetermined upper limit" (Column 2, lines 20-24). Therefore it would have been obvious to combine reference one and reference two to obtain the invention as specified in claims 17 and 36.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,064,836 by Nakamura et al.
18. Regarding claim 18, Nakamura teaches a directory server for managing network users and resources on a network, comprising: managing means for managing management information on the number of copies for each network user; control means for sending to said copier said management information corresponding to user information obtained on logging in according to a login from the copier connected to said network (Column 6, lines 37-48).
19. Regarding claim 19, Nakamura teaches the directory server according to claim 18, further comprising: renewing means for renewing the management information on each network user according to information from said copier (Column 6, lines 37-48).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

20. The claimed invention disclosed in claims 37-44 is directed to non-statutory subject matter.
21. Regarding claims 37, 39, 41, and 43, all recite the limitation "computer program". A computer executable program is directed towards abstract ideas, since a program is like an algorithm that is being carried out (See MPEP 706.03(a)). A computer program

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is functional descriptive material, and is only statutory when embodied in a computer readable medium. Applicant may overcome this rejection by rewriting the claims as "a computer-readable storage medium storing a computer program executed on ..." (See MPEP 2106).

22. Claims 38, 40, 42, and 44 are rejected because they depend upon rejected claims

### ***Allowable Subject Matter***

23. Claims 8, 12, 27, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin O. Dulaney whose telephone number is (571) 272-2874. The examiner can normally be reached on Monday - Friday (9am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*BED*

  
TWYLER LAMB  
PRIMARY EXAMINER